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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/693,470
Filing Date: October 24, 2003
Appellant(s): PUGLIESE, PIERLUIGI

Jimmy L. Heisz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01/18/2007 appealing from the Office action mailed 11/13/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in *the brief is incorrect.* The Advisory Action was mailed on June 20, 2006, instead of June 30, 2006.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20010049263	Xiang Zhang	12-2001
20040042604	Hiltunen et al.	03-2004

20040075675

Raivisto et al.

04-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 and 10-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang (Pub. No: 2001/0049263) in view of Hiltunen et al. (Pub. No: 20040042604).

Regarding claim 1, Zhang discloses a method of ascertaining a state of a mobile communication apparatus, comprising: collecting data on at least one of individual components and procedures embedded within said mobile communication apparatus based on status quo information derived therefrom, on a memory management module or non-volatile memory 340 (fig. 1 to fig. 3, [0024], [0031] to [0033] and [0037] to [0038]); and radio transmitting said data from said mobile communication apparatus via said radio network to which said mobile communication apparatus is affiliated to a service center 130 (fig. 1 to fig. 3, [0024] and [0031] to [0038]). However, Zhang does not disclose on a subscriber information module (SIM) card.

In the same field of endeavor, Raivisto et al. disclose on a subscriber information module (SIM) card ([0033]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mobile station of Zhang by specifically including on a subscriber information module (SIM) card, as taught by Hiltunen et al., the motivation being in order to store data such as the content provided by a service provider, so that the content is not lost upon power down of the mobile terminal. Additionally, it provides a simple and quick procedure which eliminates unnecessary wear and tear on the SIM.

Regarding claim 2, the combination of Zhang and Hiltunen et al. disclose all the limitations in claim 1. Further, Zhang discloses the method wherein said collecting is performed by using a trace routine ([0031] to [0033] and [0035] to [0038]).

Regarding claim 3, the combination of Zhang and Hiltunen et al. disclose all the limitations in claim 1. Further, Zhang discloses the method wherein said transmitting is performed by using a selected one of an SMS and a predefined data call ([0029]).

Regarding claim 4, the combination of Zhang and Hiltunen et al. disclose all the limitations in claim 1. Further, Zhang discloses the method wherein said data are coded in a space-efficient format prior to performing said radio transmitting ([0029] and [0039] to [0042]).

Regarding claim 5, the combination of Zhang and Hiltunen et al. disclose all the limitations in claim 1. Further, Zhang discloses the method wherein said data are stored prior to performing said radio transmitting ([0037] to [0038]).

Regarding claim 6, the combination of Zhang and Hiltunen et al. disclose all the limitations in claim 1. Further, Zhang discloses the method wherein said radio transmitting is performed in regularly spaced intervals ([0030] and [0039]).

Regarding claim 10, the combination of Zhang and Hiltunen et al. disclose all the limitations in claim 1. Further, Zhang discloses the method wherein said data are transferred between said mobile communication apparatus and said network without signaling said user of said mobile communication apparatus ([0030]).

Regarding claim 11, the combination of Zhang and Hiltunen et al. disclose all the limitations in claim 1. Further, Zhang discloses the method wherein said data are weighted ([0037] to [0038]).

Regarding claim 12, the combination of Zhang and Hiltunen et al. disclose all the limitations in claim 1. Further, Zhang discloses the method wherein a selected one of said collecting and said transmitting is carried out dependent on selectable information items ([0037] to [0039]).

Regarding claim 13, this claim is rejected for the same reason as set forth in claim 1.

Regarding claim 14, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 15, this claim is rejected for the same reason as set forth in claim 3.

Regarding claim 16, this claim is rejected for the same reason as set forth in claim 4.

Regarding claim 17, this claim is rejected for the same reason as set forth in claim 5.

Regarding claim 18, this claim is rejected for the same reason as set forth in claim 6.

Regarding claim 19, this claim is rejected for the same reason as set forth in claim 7.

Regarding claim 20, this claim is rejected for the same reason as set forth in claim 8.

Regarding claim 21, this claim is rejected for the same reason as set forth in claim 9.

Regarding claim 22, this claim is rejected for the same reason as set forth in claim 10.

Regarding claim 23, this claim is rejected for the same reason as set forth in claim 11.

Regarding claim 24, this claim is rejected for the same reason as set forth in claim 12.

Regarding claim 25, the combination of Zhang and Hiltunen et al. all the limitations in claim 13. Further, Zhang discloses the mobile communication apparatus wherein said mobile communication apparatus is a mobile phone adapted to operate on a selected one of a GSM standard and a UMTS-standard ([0025]).

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang (Pub. No: 2001/0049263) in view of Hiltunen et al. (Pub. No: 20040042604) and Further in view of (Pub. No: 20040075675).

Regarding claim 7, the combination of Zhang and Hiltunen et al. disclose all the limitations in claim 1. However, the combination of Zhang and Hiltunen et al. do not disclose the method wherein said radio transmitting is performed during an initializing menu procedure.

In the same field of endeavor, Raivisto et al. disclose the method wherein said radio transmitting is performed during an initializing menu procedure ([0026], [0044] and [0047] to [0048]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mobile station of the combination of Zhang and Hiltunen et al. by specifically including the method wherein said radio transmitting is performed during an initializing menu procedure, as taught by Raivisto et al., the motivation being in order to reduce user burden in manipulating the mobile terminal to invoke the proper access methodology.

Art Unit: 2617

Additionally, it allows the service providers and operators to facilitate the offering of their services and applications to end users.

Regarding claim 8, the combination of Zhang and Hiltunen et al. and Raivisto et al. disclose all the limitation in claim 7. Further, Raivisto et al. disclose the method wherein said menu procedure is activated during a selected one of when said mobile communication apparatus is logged-in to said network and when said mobile communication apparatus is logged-off from said network ([0026], [0044] and [0047] to [0048]).

Regarding claim 9, the combination of Zhang and Hiltunen et al. and Raivisto et al. disclose all the limitation in claim 7. Further, Raivisto et al. disclose the method wherein said menu procedure is activated by a selected one of said user of said mobile communication apparatus and externally via said network ([0026], [0044] and [0047] to [0048]).

(10) Response to Argument

1. Appellant, on page 7 of the Brief, argues that the Examiner's Office Action dated November 13, 2006, is not a model of clarity, Appellant will attempt to address the points as best understood. For example, while stating that Zhang does not describe or disclose a SIM card, the Examiner writes, at the bottom of page 3, "[i]n the same field of endeavor, Raivisto et al disclose [sic] on a subscriber information module (SIM) card ([0033])."

In response to the Appellant's brief, while writing the final rejection on 11/13/2006, the Examiner cut and pasted from the previous office action (mailed on 03/13/2006) to the final office action (mailed on 11/13/2006), the Examiner inadvertently inserted the reference "Raivisto

et al.” instead of the reference “Hiltunen”. The Examiner believes that it was a typo error and has since corrected the passage.

2. Appellant, on page 8 to page 9 of the Brief, argues that Hiltunen does not teach or suggest that a SIM card can be provisioned or programmed with a routine for collecting data on at least one individual component or procedure embedded within a mobile communication apparatus based on status quo information. However, the Examiner respectfully disagrees.

First, Hiltunen discloses in Fig. 14, paragraph 32 to paragraph 33 that a phone comprises a SIM card controller 4 or microprocessor 4 and a memory module receiver 10 or a SIM card holder 10. The SIM card 208 (see Fig. 2) is generally mounted in the SIM card holder 10 and reading of data from or to the SIM card is controlled by a SIM card controller 4. The SIM card 208 may store subscriber number, system ID, charge meter information, function control information and other data. The other data stored on the SIM card may be used by the microprocessor for, e.g., to control, modify or monitor the operation of the phone. In addition, Hiltunen discloses in paragraph 33 that the SIM card is not a passive memory card, but also a processor card which includes not only a memory, but a facility for internally processing information (software). As mentioned above, the SIM card stores function control information and other data. The other data stored in the SIM may be used by the microprocessor to modify or monitor the operation of the phone. Therefore, it is obvious that the SIM card 208 includes a software which instructs the processor to collect components data and provides that data to the microprocessor 4 for monitoring the operation of the phone.

Second, in response to Appellant’s response against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based

on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the Office Action was mailed on 11/13/2006, the Examiner stated that Zhang discloses the memory management 340 is non-volatile memory or EEPROM memory used to store performance error of components of the phone. Because, Zhang does not disclose that the memory management 340 is a SIM card. On the other hand, Hiltunen discloses that a SIM card collects components' data of the phone and provides that data to the microprocessor 4 for monitoring the operation of the phone. Therefore, the Examiner maintains that the combination of Zhang and Hiltunen meet the claimed invention.

3. Appellant, on page 9 of the Brief, argues that there is no suggestion or teaching in Zhang and Hiltunen, taken together, that would motivate one of ordinary skill in the art to arrive at the claimed invention, much less enable the present invention. Thus, Zhang, individually or in combination with Raivisto, fails to teach or suggest the invention recited in independent Claims 1 and 13. However, the Examiner respectfully disagrees.

In this regard, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Zhang discloses in Fig. 3, paragraph 31 and paragraph 35 that a mobile station 10 comprises maintenance task module 310, call processing module 320, user interface module 330, memory management module 340 (see paragraph 34, the memory management module 340 includes non-volatile memory or EEPROM memory) and

other tasks module 350. During use, each module 320, 330, 340 and 350 contains software which allows it to recognize any errors generated within their specific processing. These errors are transmitted from each module 320, 330, 340 and 350 to maintenance task module 310 along transmission signals 322, 332, 342 and 352, respectively (please see paragraph 33). Maintenance task module 310 analyzes each of these errors to determine if they are errors which have been previously reported or if they are new errors and the importance of the errors. *After processing this information, required information regarding these errors are transmitted to memory management module 340 via signal 344. Thus, memory management module 340 maintains the appropriate performance and error data logs, preferably compiling the number of times a particular error has occurred, the types of errors which have occurred, and any other performance data required by the system.* The main task module 310 monitors these performances and determines when these performances error should be transmitted to service center. Because, Zhang does not disclose the memory management module 340 is a SIM card. On the other hand, Hiltunen discloses a SIM card which collects data on components for monitoring or modifying the operation of a phone (please see paragraph 33), similar to the data collection of Zhang. Moreover, Hiltunen discloses the SIM card is not a passive memory card, but also a processor card which includes not only a memory, but a facility for internally processing information (software). For that reason, the examiner contends that Zhang is properly combinable with Hiltunen and there is a suggestion or motivation to combine these references, e.g., the information contained in a SIM may be transferred from one portable radiotelephone to another without having to physically transfer the SIM (paragraph 12).

4. Appellant, on page 9 to page 10 of the Brief, argues that neither reference (Zhang and Hiltunen) teaches or suggests a method or apparatus for ascertaining the state of a mobile communication apparatus by using a SIM card for collecting data on at least one of the individual components and procedures embedded within the mobile communication apparatus. However, the Examiner respectfully disagrees.

Zhang discloses in Fig. 3, paragraph 31 and paragraph 35 that a mobile station 10 comprises maintenance task module 310, call processing module 320, user interface module 330, memory management module 340 (see paragraph 34, the memory management module 340 includes non-volatile memory or EEPROM memory) and other tasks module 350. During use, each module 320, 330, 340 and 350 contains software which allows it to recognize any errors generated within their specific processing. These errors are transmitted from each module 320, 330, 340 and 350 to maintenance task module 310 along transmission signals 322, 332, 342 and 352, respectively (please paragraph 33). Maintenance task module 310 analyzes each of these errors to determine if they are errors which have been previously reported or if they are new errors and the importance of the errors. *After processing this information, required information regarding these errors are transmitted to memory management module 340 via signal 344. Thus, memory management module 340 maintains the appropriate performance and error data logs, preferably compiling the number of times a particular error has occurred, the types of errors which have occurred,* and any other performance data required by the system.

However, Zhang does not disclose that the memory management 340 is a SIM card. On the other hand, Hiltunen discloses that a SIM card uses to collect data on components of the phone and provides that data to microprocessor for monitoring or modifying the operation of a

phone (please see paragraph 33). Moreover, Hiltunen discloses the SIM card is not a passive memory card, but also a processor card which includes not only a memory, but a facility for internally processing information. As is well known in the art that SIM card includes software for instructing the processor to collect data and monitor the operation of components of the phone. For that reason, the examiner contends that the combination of Zhang and Hiltunen disclose the method or apparatus for ascertaining the state of a mobile communication apparatus by using a SIM card for collecting data on at least one of the individual components and procedures embedded within the mobile communication apparatus.

5. Appellant, on page 10 of the brief, argues that in the November 13, 2006, Final Rejection, the Examiner states that the motivation to combine Zhang and Hiltunen was "...in order to store data such as the content provided by a service provider, so the content is not lost upon power down of the mobile terminal." The Examiner also stated an additional reason of "..., it provides a simple and quick procedure which eliminates unnecessary wear and tear on a SIM." The first of these two reasons is not a motivation for ascertaining the state of a mobile communications apparatus by using a SIM card for collecting data on at least one of the individual components and procedures embedded within the mobile communications apparatus. Neither the prior art nor Appellant's application address any need to store data so that it would not be lost on power down. This problem, if it is one, is simply not addressed. The second reason set forth by the Examiner is also not a valid motivation. The use of the SIM card must first be suggested before a person skilled in the pertinent art would even need to worry about eliminating unnecessary wear and tear on the SIM card. Neither reason provided by the Examiner provides motivation why a person skilled in the pertinent art should consider the use of a SIM card to ascertain the

state of a mobile communication apparatus by collecting data on at least one of the individual components and procedures embedded within the apparatus. Not only are all of the elements of the present invention not provided for in the cited references, but there is no suggestion or teaching in the art that would motivate one of ordinary skill in the art to arrive at the claimed invention by combining the two references. However, the Examiner respectfully disagrees.

First, in response to Appellant's brief, the fact that Appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In the Office Action was mailed on 11/13/2006, the Examiner stated that Zhang discloses the memory management 340 is non-volatile memory or EEPROM memory uses to store performance error of components of the phone. However, Zhang does not disclose that the memory management 340 is a SIM card. On the other hand, Hiltunen discloses that a SIM card collects components' data of the phone and provides that data to the microprocessor 4 for monitoring the operation of the phone. Therefore, the examiner contends that Zhang is properly combinable with Hiltunen and there is a suggestion or motivation to combine these references, e.g., the information contained in a SIM may be transferred from one portable radiotelephone to another without having to physically transfer the SIM (paragraph 12).

Second, in response to Appellant's brief that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As explained above, Zhang discloses the memory management 340 is non-volatile memory or EEPROM memory uses to store performance error of components of the phone. However, Zhang does not disclose that the memory management 340 is a SIM card. On the other hand, Hiltunen discloses that a SIM card collects components' data of the phone and provides that data to the microprocessor 4 for monitoring the operation of the phone. Therefore, the examiner contends that Zhang is properly combinable with Hiltunen and there is a suggestion or motivation to combine these references, e.g., the information contained in a SIM may be transferred from one portable radiotelephone to another without having to physically transfer the SIM (paragraph 12).

7. Appellant, on page 10 to page 11 of the Brief, argues that there is *no suggestion* or teaching in Zhang, in view of Hiltunen, to collect data on a SIM card on at least one of the individual components and procedures embedded within a mobile station based on status quo information. Therefore, independent Claims 1 and 13, as rejected by the Examiner, are not obvious under 35 U.S.C. §103(a) over Zhang in view of Hiltunen. Because Claims 2-6, 10-12 and 14-25 are each respectively dependent upon either independent Claim 1 or 13, they are also not obvious under 35 U.S.C. §103(a) over Zhang in view of Hiltunen. However, the Examiner respectfully disagrees.

Zhang discloses in Fig. 3, paragraph 31 and paragraph 35 that a mobile station 10 comprises maintenance task module 310, call processing module 320, user interface module 330, memory management module 340 (see paragraph 34, the memory management module 340

Art Unit: 2617

includes non-volatile memory or EEPROM memory) and other tasks module 350. During use, each module 320, 330, 340 and 350 contains software which allows it to recognize any errors generated within their specific processing. These errors are transmitted from each module 320, 330, 340 and 350 to maintenance task module 310 along transmission signals 322, 332, 342 and 352, respectively (please paragraph 33). Maintenance task module 310 analyzes each of these errors to determine if they are errors which have been previously reported or if they are new errors and the importance of the errors. *After processing this information, required information regarding these errors are transmitted to memory management module 340 via signal 344. Thus, memory management module 340 maintains the appropriate performance and error data logs, preferably compiling the number of times a particular error has occurred, the types of errors which have occurred, and any other performance data required by the system.* However, Zhang does not disclose the memory management module 340 includes non-volatile memory or EEPROM memory is a SIM card.

On the other hand, Hiltunen discloses that a SIM card which collects data on components for monitoring or modifying the operation of a phone (please see paragraph 33). Moreover, Hiltunen discloses the SIM card is not a passive memory card, but also a processor card which includes not only a memory, but a facility for internally processing information. For that reason, the examiner contends that Zhang is properly combined with Hiltunen and there is a suggestion or motivation to combine these references, e.g., the information contained in a SIM may be transferred from one portable radiotelephone to another without having to physically transfer the SIM.

8. Appellant, on page 11 of the Brief, argues that Raivisto is similar to Hiltunen in that it describes a system for facilitating the provisioning of services and the execution of those services at mobile terminals **and not to a method or apparatus for** ascertaining the state of a mobile communication apparatus by using a SIM card for collecting data on at least one of the individual components and procedures embedded within the mobile terminal. Furthermore, on page 11 to page 12 of the Brief, argues that Raivisto contains neither teaching or suggestion *that a SIM card can be provisioned* or programmed with a routine for collecting data on at least one individual component or procedure embedded within a mobile communication apparatus based on status quo information. However, the Examiner respectfully disagrees.

First, in response to Appellant's response against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Second, Raivisto discloses in paragraph 48 that a service provider may configure a SIM card 502 in a mobile terminal 508 in order to provide a list of services to a mobile user.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

Dai Phuong


Art Unit: 2617

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